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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,286	11/12/2003	Robert J. Mills	14649	9293

7590

08/23/2006

SHELDON & MAK  
9th Floor  
222 South Lake Avenue  
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EXAMINER
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AYRES, TIMOTHY MICHAEL

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,286

Applicant(s)

MILLS ET AL.

Examiner

Timothy M. Ayres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second section with a pair of opposed side walls as recited in claims 9, 12, 15, and 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Regarding claims 9-16, A first section with a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall is not described in the specification. A second section with a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall is not described in the specification. The specification refers to a lower and upper compartment of the pencil case. Assuming that the first and second section are the upper and lower compartment the specification still does not define the bottom wall, the pair of opposed sidewalls, the front wall, and the rear wall for each compartment and only defines a bottom wall, a pair of opposed sidewalls, a front wall, and a rear wall for the entire pencil case.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 9, 12, 15, and 16, assuming that the

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second section refers to the lower compartment (46) it is unclear how the second section has a pair of opposed side walls since from the drawing it appears to be an elliptical shape and the specification is silent to the walls of each compartment and only discusses the walls of the whole pencil case.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 9 recites the limitation "the bottom wall of the pencil case" in line 15. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this refers to the bottom wall of the first section or the second or both or some other bottom wall of the pencil case. For examination purposes it has been assumed to be just a general or other bottom wall.

8. Claim 12 recites the limitation "the bottom wall of the pencil case" in line 18. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this refers to the bottom wall of the first section or the second or both or some other bottom wall of the pencil case. For examination purposes it has been assumed to be just a general or other bottom wall.

***Claim Rejections - 35 USC § 103***

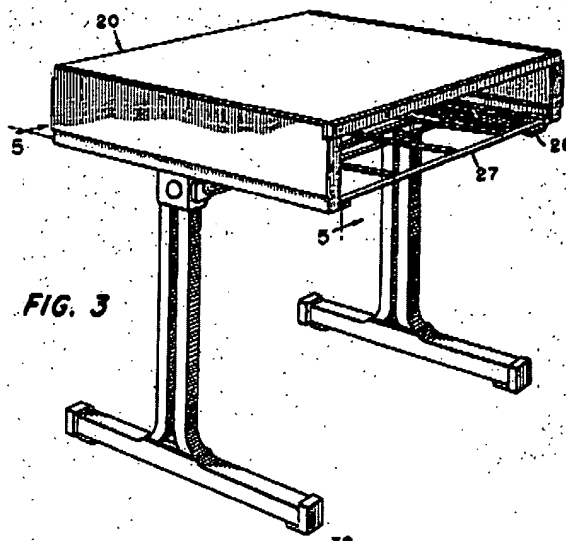
9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,758,182 to Barecki in view of US Patent 2,535,743 to Lundahl and US Patent 6,056,178 to Rapp-Duncan. . Barecki ('182) teaches in Fig. 3, a desk (20) with a top (21) and a support structure (24). The desk (20) is bottomless with support runners (26) that define the front opening. The runners (26) support a bottom rack (27), which is made of wire mesh and has many openings. In figures 6 and 7 Barecki teaches a pencil case (28) that could replace the bottom rack (27) on the desk and thus is teaching a desire to have a pencil case in that location.



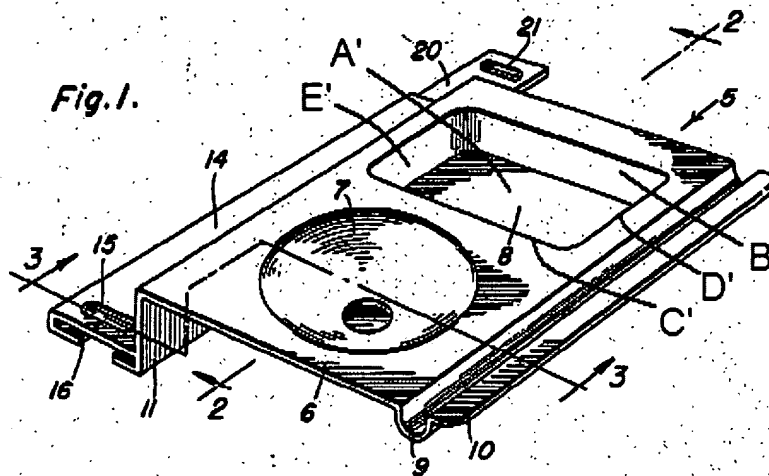
Barecki ('182) Fig. 3

12. Barecki ('182) does not disclose expressly a pencil case attached with a pencil case attachment plate to the bookrack, a portion of the pencil case being disposed below the bottom wall of the book rack, and the pencil case with a bottom wall, a pair of opposed side walls, a front wall and a rear wall.

13. Lundahl teaches a pencil case (5) that has a portion (14) that is below the bottom of the typewriter (13) and the portion (14) is considered a bottom wall of the pencil case (5). The pencil case (5) has a first section (8) with a bottom wall (A'), opposing side walls (B', C'), a front wall (D'), and a rear wall (E'). The first section (8) is sized to retain a ruler or protractor within the walls. Rulers and protractors come in many sizes including some that are relatively small. Also note; a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The pencil case is comprised of an upper compartment/ first section

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(8) and a lower compartment/second section (7). The lower compartment (7) is disposed next to or outside the typewriter (13). The second section (7) has a bottom wall and walls in the shape of circle and the circular wall is considered to be made of a front wall, a rear wall, and opposing side walls integral formed together. A third section (9) is higher than the first section and has a bottom wall, front wall, and a rear wall.



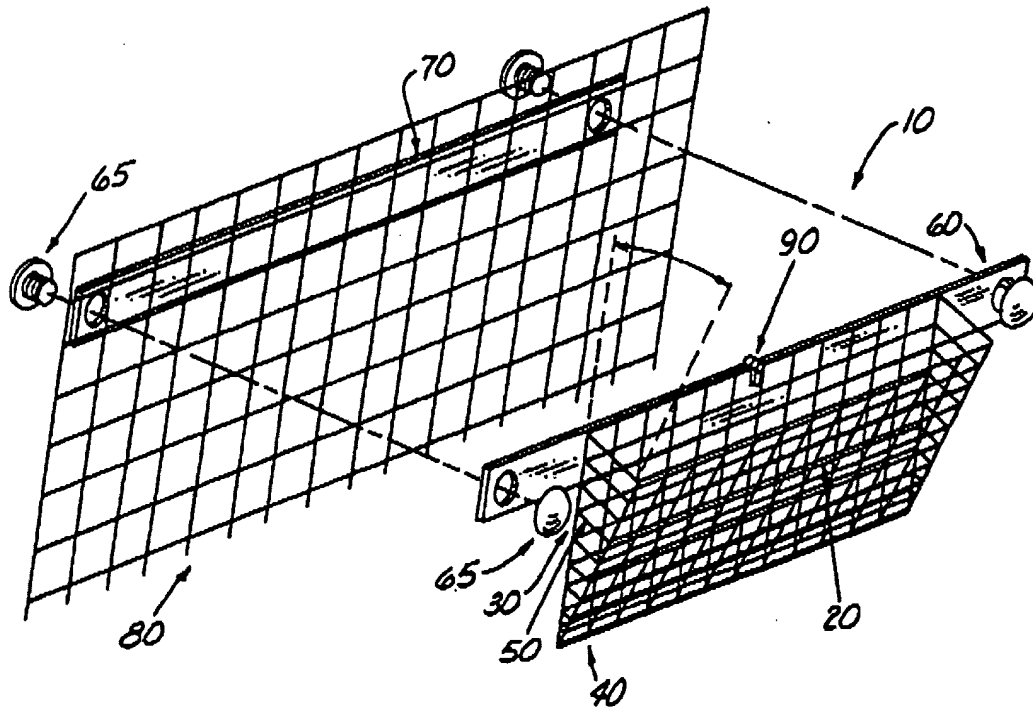
Lundahl '743 Figure 1

14. Rapp-Duncan teaches an auxiliary bin for a shopping cart. The shopping cart (80) is made form wire mesh. The bin (10) is made form a smaller wire mesh and is attached to a bar (60). The wire mesh shopping cart (80) is sandwiched between a attachment plate (70) and the bar (60) on the bin (10).

15. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the desk and book rack of Barecki by adding the pencil case as taught by Lundahl in the manner as taught by Rapp-Duncan since the pencil case would



allow items such as pencils to be kept near the desk (Lundahl '743, col. 1, lines 7-20) and the attachment would be simple (Rapp-Duncan '178, Col. 2, lines 31-33).



Rapp-Duncan '178 Figure 1

16. Regarding claims 11, and 14, at the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the book rack and pencil case of Barecki in view of Lundahl and Rapp-Duncan by removing the flange (11) on the pencil case (5) since the purpose of the flange (11) was to raise the compartments off of the tabletop and in the current location this is not needed and it would be cheaper and easier to manufacture with out the flange (Lundahl '743, Col. 2, lines 9-13). This would

casue the lower compartment to be in a plane below a plane of the bottom of the book rack.

### ***Response to Arguments***

17. Applicant's arguments filed 6/21/06 have been fully considered but they are not persuasive. Lundahl teaches an attachment portion (14) that is considered a bottom wall of the pencil case (5). Lundahl teaches a configuration with a first and second section as substantially claimed, additionally it would be obvious to use the third section with added opposing side walls to replace the first or second section. Lundahl does not teach a pencil case attachment plate or the case attached to a wire mesh book rack.

This deficiency is taught in the reference to Rapp-Duncan who teaches an attachment plate when attaching a bin to a wire mesh structure. Barecki does not teach away from the invention by using a pencil case a replacement of the bookrack; instead he shows the need of a desk with a bookrack and a pencil case.

18. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

19. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Ayres whose telephone number is (571) 272-8299. The examiner can normally be reached on MON-THU 8:00 - 5:00.

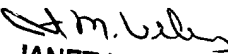
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TMA  
8/16/06



  
JANET M. WILKENS  
PRIMARY EXAMINER  
Art Unit 3637